

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK ACHENBACH and HERBERT BARTHEL

Appeal No. 1998-0138
Application 08/381,809¹

ON BRIEF

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER and TORCZON,
Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

Decision on Appeal under 35 U.S.C. § 134

Applicants appeal from the rejection of claims 5-7, 13 and 16-19. We have jurisdiction pursuant to 35 U.S.C. § 134.

The invention relates to heat-stabilized silicone rubber. Applicants claim two embodiments: (1) a precursor composition capable of being cross-linked to form a silicone rubber (claims 5-15) and (2) a method of increasing the heat stability or heat resistance of silicone rubber (claims 16-21). The composition includes at least four components: (a) a palladium compound in a heat-stabilizing effective

¹ Application for patent filed February 1, 1995.

amount; (b) a polyorganosiloxane having at least two alkenyl groups per molecule; (c) a polyorganosiloxane having at least two SiH groups per molecule; and (d) a hydrosilylation catalyst. The palladium compound (component (a)) is also limited to those that “exhibit[] substantially no hydrosilylation catalytic activity.” The method claims include the steps of adding a heat-stabilizing amount of palladium containing component (a) to components (b), (c) or (d) and forming the silicone rubber by addition crosslinking of components (b), (c) and (d).

Representative claims 5, 6 and 16 are reproduced below:

5. An addition-crosslinking silicone composition crosslinkable to a silicone rubber displaying increased heat resistance, comprising:
 - a) an effective, heat-stabilizing amount of a palladium heat-stabilizing compound;
 - b) a polyorganosiloxane having at least two alkenyl groups per molecule;
 - c) a polyorganosiloxane having at least two SiH groups per molecule;
 - d) a hydrosilylation catalyst;wherein said palladium compound a) exhibits substantially no hydrosilylation catalytic activity, and wherein the heat resistance of said silicone rubber is greater than an otherwise similar rubber not containing said palladium compound a).
6. The composition of claim 5 wherein said palladium heat-stabilizing compound is selected from the group consisting of:
 PdX_2 , L_2PdX_2 , $\text{L}_2\text{Pd}_2\text{X}_2$, L_4PdX_2 , L_2PdX_4 , PdL_4 , M_2PdX_4 or M_2PdX_6 , in which
X is an inorganic ligand selected from the group consisting of the halides, NO_2 , NO_3 , 0.5 SO_4 , and CN; a carboxylic acid radical of the formula OCOR' in which R' is an unsubstituted or substituted alkyl, cycloalkyl, or aryl radical having 1-20 carbon atoms; a complexing unsubstituted or substituted organic anion; and OH;

- L is a donor selected from the group consisting of amines of the formula NR''_3 wherein each R'' individually is hydrogen, alkyl, cycloalkyl, or aryl; diamines; bipyridyl; phosphorus containing ligands of the formulae PR''_3 and $Ph_2P-(CH_2)_n-PPh_2$ where n is 1 or 2; nitriles; and dienes; and
- M is hydrogen, NH_4 , an alkali metal, or an alkaline earth metal;

and mixtures thereof.

16. A method of increasing the heat resistance of a silicon rubber prepared by the addition of crosslinking of polysiloxanes containing two or more alkenyl groups (1) with polysiloxanes containing two or more SiH groups, (2) in the presence of a hydrosilylation catalyst, (3) said method comprising:
adding to one or more of (1), (2) or (3) an effective, heat-stabilizing amount of a heat-stabilizer comprising palladium or a palladium compound, wherein said palladium or said palladium compound exhibits substantially no hydrosil[yl]ation catalytic activity.

In the Answer, the examiner maintains the following grounds of rejection:

1. The rejection of claims 5 and 16 under 35 U.S.C. § 112, ¶ 1, for failing to be supported by a written description for the limitation that the palladium compound “exhibits substantially no hydrosilylation activity.” Paper 15, p. 4.
2. The rejection of claims 5-7, 13 and 16-19 under 35 U.S.C. § 103(a) as unpatentable over Kobayashi.² Paper 15, p. 4.

The Answer also added the following new ground of rejection:

3. The rejection of claims 6, 7 and 18 under 35 U.S.C. § 112, ¶ 1, as being broader than the enabling disclosure. Paper 15, p. 5.

² U.S. Patent 5,106,933, granted April 21, 1992, on application 07/535,448, filed June 8, 1990.

The rejection of claims 5 and 16 under 35 U.S.C. § 112, ¶ 1, for lack of a written description

The examiner has rejected claims 5 and 16 under 35 U.S.C. § 112, ¶ 1, because the specification as originally filed did not include a written description of the limitation requiring that the palladium compound “exhibits substantially no hydrosilylation catalytic activity.” The quoted language does not appear in the disclosure as originally filed, but was added by amendment in response to rejection of the original claims. Paper 5, p. 2. We reverse.

The general test for determining whether later claimed subject matter is supported by an earlier written description is whether the disclosure of the application “reasonably conveys to a person skilled in the art that the inventor had possession of the claimed subject matter at the time of the earlier filing date.” Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). To comply with the written description requirement, the specification must provide information that clearly allows persons having ordinary skill in the art to recognize that the applicant invented what is claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). In Vas-Cath the court noted that the disclosure must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.” Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117 (emphasis original). The court went on to state that the “invention is, for the purpose of the 'written description' inquiry, whatever is now claimed.” Vas-Cath, 935 F.2d at 1564, 19 USPQ2d at 1117 (emphasis original). However, where different language is relied upon for support, “the specification must contain an equivalent description of the claimed subject matter.” Lockwood v. American Airlines, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Wagoner v. Barger, 463 F.2d 1377, 1380, 175 USPQ 85, 86 (CCPA 1972).

The examiner bears the burden of establishing the prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Rhinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). To meet this burden, the examiner must present a factual basis supporting the conclusion that a prima facie case exists. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); In re Lunsford, 357 F.2d 385, 392, 148 USPQ 721, 726 (CCPA 1966); In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970). In order to meet the burden of establishing the prima facie case of lack of written description, the examiner must explain why one having ordinary skill in the art would not recognize that the applicant invented the subject matter now claimed. This requires an analysis of the entire specification as originally filed. As noted above, the limitation, which is present in all claims, not just claims 5 and 16, was added by amendment. Applicants do not assert that the limitation is identically present in the specification. Rather, they assert that limitation is implicitly described in certain portions of the specification. The examiner's total explanation for the rejection is stated on page 4 of his answer:

The claims now state that the "palladium compound" does not contain any hydrosilylation catalytic activity. Applicants' clearly do [not] have any basis for such a negative limitation.

Answer, p. 4. This allegation is insufficient to satisfy the examiner's burden of establishing a prima facie case of unpatentability for failure to meet the written description requirement. Merely pointing to the fact that the specification does not expressly state the negative limitation does not meet this burden. "It is not necessary that the claimed subject matter be described identically [in the written description]" In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984); In re Lukach, 442 F.2d 967, 968-69, 169 USPQ 795, 796 (CCPA 1971) (The written description requirement does not require in haec verba antecedence in the originally filed application). Where a

new limitation is not identically set forth in the specification, then the examiner must determine whether the limitation was actually described but in different language. The examiner's conclusory statement in the Answer does not provide any explanation or basis for finding that the limitation is not implicitly present in the specification. This is part of the examiner's initial burden. Accordingly, we reverse the rejection of claims 5 and 16 for failure to

provide a written description for the limitation "wherein said palladium compound a) exhibits substantially no hydrosilylation catalytic activity."³

The rejection of claims 5-7, 13 and 16-19 under 35 U.S.C. § 103(a)

The examiner has rejected claims 5-7, 13 and 16-19 under 35 U.S.C. § 103(a) as unpatentable over Kobayashi. It is clear from the examiner's submissions that for the purpose of the prior art rejection the examiner treated the claims as **not** including the limitation that the palladium compound exhibits substantially no hydrosilylation catalytic activity. However, the invention of the claims before us includes this limitation. The examiner concedes that if the limitation is considered, the claims "would be allowable over the cited art." Reply Brief, p. 3. Since the limitation is part of the claims, we reverse the rejection under 35 U.S.C. § 103(a).

³ In this regard it should be noted that we are not holding that the questioned limitation is supported by a written description. Rather, we hold only that the examiner has not met his burden of proving that it was not supported. While applicants refer to certain portions of the specification and argue that one skilled in the art would recognize that the palladium compounds in the specification must lack catalytic activity (Brief pp. 9-12), applicants have not provided any evidence as how a person skilled in the art would understand the statements in the specification. We are given only the arguments of counsel. Arguments of counsel can not take the place of evidence lacking in the record. Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997); Knorr v. Pearson, 617 F.2d 1368, 1373, 213 USPQ 196, 200 (CCPA 1982); In re Langer, 503 F.2d 1380, 1395, 183 USPQ 288, 299 (CCPA 1974).

The rejection of claims 6, 7 and 18 under 35 U.S.C. § 112, ¶ 1, as being broader than the enabling disclosure

The examiner entered a new ground of rejection in his Answer (Paper 15),

The entire statement of this rejection follows:

Claims 6, 7 and 18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the unsubstituted species (in general) of the claimed catalysts, the specification does not reasonably provide enablement for the “substituted” catalysts with respect to the R' group of the said claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants do [not] have proper basis for every known species of substituent.

Answer, p. 5. Claims 6, 7 and 18 specify that the palladium compounds may include “a carboxylic acid radical of the formula OCOR' in which R' is an unsubstituted or substituted alkyl, cycloalkyl, or aryl radical having 1-20 carbon atoms” In the examiner’s view, applicants’ written description does not teach any one skilled in the art to make and use the invention where R' is substituted alkyl, cycloalkyl, or aryl radical having 1-20 carbon atoms.

In order to be enabling, a specification “must teach those skilled in the art how to make and use the full scope of the claimed invention without ‘undue experimentation.’” PPG Industries Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1564, 37 USPQ2d 1618, 1623 (Fed. Cir. 1996); In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Vaeck, 947 F.2d 488, 495-96, 20 USPQ2d 1438, 1444-45 (Fed. Cir. 1991).

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of Section 112 unless there is reason to doubt the

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objective truth of the statements contained therein which must
be relied on for enabling support.

In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). It follows that the
examiner has the initial burden of challenging a presumptively correct assertions in the disclosure.
Marzocchi, 439 F.2d at 224, 169 USPQ at 370. It is incumbent upon the examiner, whenever a
rejection on this basis is made, to explain why he doubts the truth or accuracy of any statement in a
supporting disclosure and to back up assertions of his own with acceptable evidence or reasoning
which is inconsistent with the contested statement. Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

The examiner has not met this burden. As seen from the rejection quoted above, the examiner
has set forth only the unsupported assertion that the one skilled in the art would consider the
specification not to be enabling. The examiner has not provided any evidence or any reasoning
supporting the conclusion that a person skilled in the art would be required to undertake an undue
amount of experimentation to use the invention with a palladium compound including a carboxylic acid
radical of the formula OCOR' in which R' is substituted.

The rejection of claims 6, 7 and 18 is reversed.

REVERSED

FRED E. McKELVEY, Senior
Administrative Patent Judge

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